

### REMARKS

Following entry of the amendments, claims 37-80 remain pending in the application. Claims 1-36 have been cancelled without prejudice or disclaimer. Claims 37-80 have been added. The added claims are supported by the original claims and consistent with the disclosure, for example on pages 7-17. Applicant submits that no new matter is entered by way of amendment.

Favorable consideration of the following comments with respect to the outstanding Restriction Requirement is respectfully requested.

#### **Restriction Under 35 USC § 121 and Election of Species**

In the Restriction Requirement, the Patent Office has required restriction of the originally pending claims to one of four inventive groups:

Group I (Claims 1, 5, 6, 10, 11, and 27-31) drawn to a method of obtaining CD34-negative cells comprising the step of contacting CD34-positive cells with a flt-3 ligand and a stem cell factor, classified in Class 435, subclass 375;

Group II (Claims 1, 2, 5-7, 10-12, 15, 18, and 21-34) drawn to a method of differentiating cells to form a proliferated population of mucosal mast cells (MC<sub>T</sub>), cells produced by the method, and a method of using the MC<sub>T</sub> cells for screening, classified in Class 435, subclass 377;

Group III (Claims 1, 3, 5, 6, 8, 10, 11, 13, 16, 19, 21-33, and 35) drawn to a method of differentiating cells to form a proliferated population of connective tissue mast cells (MC<sub>TC</sub>), cells produced by the method, and a method of using MC<sub>TC</sub> cells for screening, classified in Class 435, subclass 377; and

Group IV (Claims 1, 4, 5, 6, 9-11, 14, 17, 20-33, and 36) drawn to a method of differentiating cells to form a proliferated population of basophils, cells produced by the method, and a method of using the basophils for screening, classified in Class 435, subclass 377.

Applicant elects the claims of Group II, with traverse, for further prosecution on the merits. Applicants request reconsideration of the restriction requirement in view of the following remarks.

The Patent Office has classified the claims of Group II and III in the same class and subclass. The subject matter of both groups are drawn to methods of generating mast cells, cells produced by the claimed method, and a method of using the cells for screening purposes. Thus, Groups II and III differ only with respect to the type of mast cells.

Considering the overlap of subject matter, a search and examination of the claims of one group would impose no more burden than a search and examination of both groups together. Thus, a restriction between the two inventive groups should not be maintained.

Furthermore, MPEP § 809.02 and 37 CFR § 1.146 provides that if an application contains a generic claim linking a number of species claims, a restriction requirement is limited to a proper election of species. The rationale is that if the species claims are written in dependent form or include all the limitations of the generic claim, the species claims are necessarily allowable if the generic claim is found allowable. Importantly, there is no serious burden on the Examiner because should a generic claim be allowable, no further search is required as to the other related species claims. Hence, as provided in 37 CFR § 1.141(a) and MPEP § 809.03, the presence of a generic claim prevents restriction between inventions that are otherwise divisible. In these circumstances, a proper restriction is to an elected species, and requires the Examiner to (a) identify the generic claim, (b) clearly identify each of the disclosed species to which claims are to be restricted, and (c) require applicant to elect a single disclosed species. See MPEP § 809.02(a).

In the present case, the newly presented claims are related by the method of generating mast cells (i.e., claim 37) and the population of cultured mast cells formed by claimed method (i.e., claim 51), which link the subject matter of Groups II and III, thereby preventing restriction between the inventive groups.

In view of all of the foregoing, Applicant requests that the restriction requirement be reformulated to a single inventive group encompassing the subject matter of Groups II and III, and that the newly presented claims be examined together, in accord with MPEP guidelines and statutory requirements.

The Restriction Requirement also requires Applicant to elect a single disclosed species with respect to candidate bioactive agent. Applicant elects "small molecule candidate bioactive agent." Claims 67-70 and 76-80 read on the elected species.

Applicant understands the election of species as being made solely to facilitate examination of the claims, and that he is entitled to consideration of additional species given allowance of a generic claim.

### CONCLUSION

Applicant submits that claims 37-80 satisfy all of the statutory requirements for patentability and are in condition for allowance. If the Examiner believes that there are

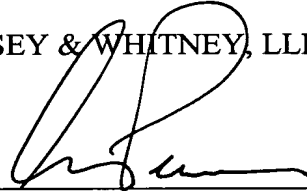
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further unresolved issues, Applicant encourages the Examiner to contact the undersigned attorney with any questions or concerns by telephone at (650) 494-8700.

Respectfully submitted,

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